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In re Application of :
ROZENBERG, Yanina et al. :
US Application No.: 10/049,871 : DECISION ON
PCT Application No.: PCT/US00/22619 :
Int. Filing Date: 18 August 2000 : PETITION UNDER
Priority Date: 19 August 1999 :
Attorney's File Reference: 271010-473 : 37 CFR 1.42 AND 1.47(a)
For: TARGETED ARTIFICIAL GENE :
DELIVERY :
:

This decision is in response to applicant's "PETITION UNDER 37 CFR 1.42 AND 1.47", filed 16 July 2002, which is being treated as a petition under 37 CFR 1.42 and 1.47(a) requesting acceptance of the application without the signature of the legal representative of deceased co-inventor Viacheslav Medvedkin (Medvedkin). The \$130.00 petition fee has been paid.

BACKGROUND

On 18 August 2000, applicants filed international application number PCT/US00/22619, which claimed priority to a prior US application filed on 19 August 1999. The application named three inventors Yanina Rozenberg (Rozenberg), Medvedkin, and W. French Anderson (Anderson).

On 19 March 2001, the applicants filed a demand for international preliminary examination. Accordingly, the thirty-month time period for paying the basic national fee in the United States of America expired at midnight on 19 February 2002.

On 12 February 2002, applicants filed a transmittal letter for entry into the national stage in the United States of America under 35 USC 371, which was accompanied by, inter alia, the basic national fee and an unsigned combined declaration and power of attorney.

On 14 May 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements which indicated, *inter alia*, that an oath or declaration of inventorship must be furnished within 2 months from the mailing date of the notification but that extensions of time were available under 37 CFR 1.136(a).

On 28 May 2002, the applicants filed the present "Petition Under 37 CFR 1.42 and 37 CFR 1.47" which was accompanied by, *inter alia*, a declaration and power of attorney and the \$130 required under 37 CFR 1.142(e) for filing the oath or declaration later than 30 months from the priority date. The petition indicates that Medvedkin is deceased but that the applicants cannot locate his legal representative. The declaration lists all three inventors Rozenberg, Medvedkin, and Anderson but only includes the signatures of Rozenberg and Anderson.

DISCUSSION

37 CFR 1.42, entitled "When the inventor is dead." states:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent. Where the inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention.

Further, 37 CFR 1.47(a) states:

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

Further, MPEP section 409.03(c) under the heading "Legal Representative of Deceased Inventor Not Available" states, in part:

37 CFR 1.47 should not be considered an alternative to 37 CFR 1.42 or 35 U.S.C. 117 since the language "cannot be found or reached after diligent effort" has no reasonable application to a deceased inventor. *In re Application Papers Filed September 10, 1954*, 108 USPQ 340 (Comm'r Pat. 1955). See 37 CFR 1.42 and MPEP § 409.01. However, 37 CFR 1.47 does apply where a known legal representative of a deceased inventor cannot be found or reached after diligent effort, or refuses to make application. In such cases, the last known address of the legal representative must be given (see MPEP § 409.03(e)).

Applicants' petition under 37 CFR 1.42 and 1.47(a) indicates that the applicants have not been able locate any of Medvedkin's family or the executor of his estate. However, MPEP section 409.03(c) makes it clear that 37 CFR 1.47 applies only where a known legal representative of a deceased inventor cannot be found or reached after diligent effort, or refuses to make application. Here, co-inventor Medvedkin's legal representative remains unknown. Applicants have stated that neither Medvedkin's family

nor the executor of his estate could be located, but have not offered any evidence of an attempt to locate Medvedkin's legal representative. Accordingly, neither 37 CFR 1.42 nor 1.47(a) is applicable.

CONCLUSION

The petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.42 and 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response to this decision will result in ABANDONMENT of the application.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Applicant is advised that, effective May 1, 2003, the Office is changing its correspondence address. Any further correspondence with respect to this matter deposited with the United States Postal Service on or after May 1, 2003 should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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